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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,035

10/31/2003

John Francis Bateman

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EXAMINER

HADDAD, MAHER M

ART UNIT

PAPER NUMBER

1644

NOTIFICATION DATE

DELIVERY MODE

03/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/699,035	Applicant(s) BATEMAN ET AL.	
	Examiner Maher M. Haddad	Art Unit 1644	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 4.
Claim(s) objected to: None.
Claim(s) rejected: 43 and 44.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Maher M. Haddad/
Primary Examiner, Art Unit 1644

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 43-44 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. .

Applicant's arguments, filed 3/4/09, have been fully considered, but have not been found convincing.

Applicant submits (under Rejection Under 35 U.S.C. § 112 Second Paragraph) that amended claim 43 and dependent claim 44 are directed to an isolated polypeptide, wherein said polypeptide comprises avon Willebrand Factor A-Related Protein (WARP) encoded by a nucleotide sequence selected from the group consisting of:

i. a nucleotide sequence having at least 95% identity to the entire nucleotide sequence set forth in SEQ ID NO:5; and

ii. a nucleotide sequence having at least 99% identity to the entire nucleotide sequence set forth in SEQ ID NO:5, and wherein said polypeptide comprises one von Willebrand Factor A (VA)-like domain, a putative metal ion-dependent adhesion site (MIDAS) motif, two fibronectin type III (F3)-like repeats, and a short proline and arginine-rich segment. Applicants assert that these amendments provide for sufficient functional activity, since one would presume that a polypeptide would be share the same functional activity as that of SEQ ID NO:5, if it was to have at least 95% or 99% identity to the entire nucleotide sequence set forth in SEQ ID NO:5 while also comprising the functional domains recited.

This is not found persuasive because the claims fail to meet the enablement requirement for the "how to use" prong of the U.S.C 112, 1st paragraph. The instant fact pattern fails to indicate that a representative number of structurally related WARP encoded by 95%/99% identity to the entire nucleotide sequence is disclosed. The artisan would not know the identity of a reasonable number of representative WARP falling within the scope of the instant claim and consequently would not have known how to use them. Again, in order to satisfy 112, first paragraph, the specification has to teach how to make and use the polypeptides of the invention not how to identify the invention. While the specification discloses how to make other sequences withing claims 43-44, however, the specification fails to describe how to test these sequences to satisfy the enablement requirement.

WARP is a multifunction protein with several domains, it is not clear what testable activity applicant is claiming. Again, the recitation of percent identity language, in the absence of a testable function and limitations regarding the sequence length over which the percent identity is required; does not allow the skilled artisan to make and use the encoding nucleic acids commensurate in scope with the instant claims without undue experimentation.